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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/915,691      | 07/25/2001  | Amy E. Messner       | 10005172-1          | 7616             |

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

CARLSON, JEFFREY D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3622

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                       |                                       |  |
|------------------------------|---------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/915,691  | <b>Applicant(s)</b><br>MESSNER ET AL. |  |
|                              | <b>Examiner</b><br>Jeffrey D. Carlson | <b>Art Unit</b><br>3622               |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is responsive to the papers filed 8/9/06.

#### ***Response to Amendment***

The amendment filed 10/24/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the short-range wireless receiver being "private" and the wireless network being "public". Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 1 and 2 refer to a *private* wireless receiver, yet there appears to be no description of the private nature in the specification. Claims 1 and 3 refer to the wireless network 108 as public, yet there appears to be no description of the public nature in the specification.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1-3 are directed to a system (apparatus), yet the claims include what appear to be method steps. For example claim 1 recites: coupon is delivered...a tender made...evidence is conveyed...etc. Similarly claim 2 recites the apparent method step: price is calculated; claim 3 recites: interface that provides...interface that accepts. Applicant should replace the method steps (in each claim) reciting accomplishment of such functions with structure programmed with the ability of the functions.
- Claims 1-2 set forth a "short range" wireless receiver, yet this is a relative term which renders the claim indefinite. The term "short range" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. While the specification mentions Bluetooth™, 802.11B, as well as other wireless technologies of presumably various ranges, the claim scope is unclear with regards to "short range". Further, it is believed that the technologies themselves do not limit the operating range, but rather the power of the transmitters and quality of the receivers.
- Claims 1-2, it is unclear what structure is provided that controls the privacy of the short range wireless signal.

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- Claim 2 sets forth an interface coupled to the WAN, yet this is believed to already be present in parent claim 1. The scope of claim 2's interface language is therefore unclear.
- Claim 2, there is no antecedent basis for the transceiver (two occurrences).
- Claim 2, there is no antecedent basis for "said signal".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Begum et al (5,420,606) in view of Fajkowski (5,905,246).**

Claims 1-5: Begum discloses a system for delivering and redeeming coupons wirelessly, comprising:

- a. a coupon service provider coupled to a plurality of valid merchants through a public wide area network (col 5, lines 31-39);
- b. delivering an electronic coupon through the public wide area network to a portable communication unit (col 2, lines 5-47 and col 3, lines 4-53);
- c. transmitting the coupon to a coupon provider via a short range private wireless receiver upon activation via a user interface (col 2, lines 5-47; col 3, lines 4-53; and col 5, lines 6-44);

d. receiving approval to redeem the coupon from the coupon provider (col 2, lines 5-47; col 3, lines 4-53; and col 5, lines 6-44); and

e. calculate the final price for the item upon receiving the approval (col 2, lines 5-47 and col 5, lines 6-44).

While Begum discloses that the coupons (promotions) are transmitted through “a modem for communication with a regional or national network” (col 3, lines 35-43) and that the system “periodically communicates with a coupon redemption center computer (not shown) for coupon crediting and accounting via radio or microwave transmitter, or by use of a low cost telephone modem” (col 5, lines 31-35), it is not explicitly disclosed that the “regional or national network” is a public wide area network, such as the Internet.

However, Fajkowski discloses a similar system for delivering and redeeming electronic coupons which transmits the coupons over a public wide area network, such as the Internet, to a coupon card (smart card) and receives the redeemed coupons from a plurality of merchant computers (col 5, lines 15-17; col 6, lines 20-26; and col 29, lines 45-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention as made to use a wide area network, such as the Internet, as the regional or national network in Begum. One would have been motivated to use such an established wide area network in order to eliminate the need for the system owner to develop and field its own private regional or national wide area network, thus decreasing the cost to set up and run the system.

While Begum discloses verifying that the data of the coupon being redeemed matches stored data of valid coupons and that the redeemed coupon information is transmitted to the remote systems controller and coupon redemption center (col 5, lines

10-39), it is not explicitly disclosed that the redeeming merchant will also be verified as a valid merchant. However, Fajkowski discloses a similar system for delivering and redeeming electronic coupons which not only verifies the coupon data, but also discloses a fraud prevention method in which merchants can be placed on a suspend list so that “their coupons are no longer accepted for reimbursement” (col 3, lines 17-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to refer to a centrally managed “suspend list” in order to validate the merchant for each attempt at coupon validation so that coupons from invalid merchants are “no longer” accepted. One would have been motivated to validate the merchant in Begum in addition to validating the coupon in order to reduce the amount of fraud as discussed by both Begum and Fajkowski.

### ***Response to Arguments***

Applicant argues that Begum periodically communicates with the central system for coupon crediting and accounting as well as fraud detection and that the claim requires merchant validation on a per-coupon request. The rejection sets forth a reasonable combination where one of ordinary skill would find it obvious to centrally manage a suspend list which is verified each time a coupon is submitted to the POS for redemption – this enables the desires of Begum to be met (coupons are no longer accepted) when the merchant has been suspended.

Applicant argues that Begum’s public wireless network is not connected to the WAN. As presented in the rejection, it would have been obvious to one of ordinary skill at the time of the invention to have provided a public WAN (Internet) connection from the

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systems controller (50) to the coupon redemption center (not shown). The public wireless network is met by the wireless connection between each message sending unit and each portable user device which represents the last leg of the coupons journey from the coupon redemption center to the systems controller to the message sending unit to the user device. The alternative delivery of coupons directly to the user devices wirelessly [5:40-45] also provides a public wireless network connected to the proposed Internet-hosted coupon redemption center.

Applicant argues that Begum's national or regional network is not the same as the Internet. Examiner understands, but points out that one of ordinary skill would find it obvious to have provided the connectivity to the coupon redemption center (not shown) via the Internet for the reason provided (simplicity and low cost).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc